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EXAMINER	
POON, KING Y	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/541,615	Applicant(s) NAMIKATA, TAKESHI	
	Examiner King Y. Poon	Art Unit 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-46* is/are pending in the application.

4a) Of the above claim(s) *1-20,35-40 and 45* is/are withdrawn from consideration.

5)☒ Claim(s) *22,23,25,26,31 and 33* is/are allowed.

6)☒ Claim(s) *21,24,27-30,32,34,41-44 and 46* is/are rejected.

7)☒ Claim(s) *41-44* is/are objected to.

8)☒ Claim(s) *1-46* are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *03 April 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *5*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

This application contains claims directed to the following patentably distinct species of the claimed invention:

I. Species of the embodiment II disclosed in fig. 4.

II. Species of the embodiment III disclosed in fig. 10.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

2. Restriction to one of the following inventions is also required under 35 U.S.C. 121:

A. Claims 13-17, (also belongs to species I, fig. 4) drawn to operating system, classified in class 717, subclass 170.

B. Claims 35-38, (also belongs to species II, fig. 10) drawn to operating system, classified in class 717, subclass 170.

C. Claims 1-12, 18-20, 39-40, 45 (also belongs to species I, fig. 4) are drawn to scanner driver, classified in class 358, subclass 474.

D. Claims 21-34, 41-44, 46 (also belongs to species II, fig. 10) are drawn to printer driver, classified in class 358, subclass 1.13.

3. Inventions A and C are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are

shown to be separately usable. In the instant case, invention operating system has separate utility such as allowing the computer to run Microsoft Word application. See MPEP § 806.05(d).

4. Inventions B and D are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention operating system has separate utility such as allowing the computer to run Microsoft Word application. See MPEP § 806.05(d).

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Mr. Brain Klock on 10/16/2003 a provisional election was made with traverse to prosecute directed to the printer driver, claims 21-34, 41-44, 46. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-20, 35-40, 45 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over

the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Claim Objections

7. Claims 41-44 are objected to because of the following informalities: 1st, "two images judged as specific image" of line 7, claim 39 appears to be an error because the specification does not appears to have support for the limitation of "adding information indicating that said image is the specific, to the image signal if image data of two image judged as specific images is stored when said judgment identifies that said image is a specified image; and 2nd, "two image" of line 7 should be "two images."

Appropriate correction is required, and the examiner is requesting the applicant to point out where in the specification is supporting the above questioned limitation.

Since the examiner cannot found support for the limitation of "adding information indicating that said image is the specific, to the image signal if image data of two image judged as specific image is stored when said judgment identifies that said image is a specified image" in the specification, it is assumed by the examiner that the image processing method is a image processing method carried out in the printer driver. If after clarification and the clarified limitation is not an image processing method of a printer driver, claims 41-44 would be withdrawn from consideration because it is not the invention elected by the applicant to be examined.

Specification

8. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

9. The abstract of the disclosure is objected to because it is not directed to the elected group of claims. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claim 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 32 recites the limitation "said judgment with the unthinned image signal is executed..." and "said image" in line 8. There is insufficient antecedent basis for this limitation in the claim because there are no judgment with unthinned image signal being claimed before.

12. Claims 41-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 41 recites the limitation "said judgment" and "said image" in line 8. There is insufficient antecedent basis for this limitation in the claim.

It is unclearly whether the judging step is referring to the judging step of line 3 of judging an image or the judging step of line 7 of judging two images.

It is unclear whether "said image" is the image of line 3 or which one of the two images of line 7.

Regarding claims 42-44: Claims 42-44 are rejected because they depend on rejected claim 41.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

14. Claims 21, 27, 30, 46 are rejected under 35 U.S.C. 102(e) as being anticipated by Kuboki et al (US 5,790,165).

Regarding claim 21: Kuboki teaches an image processing method for use in a printer driver (fig. 13, column 14, lines 22-28; a printer driver is a device that control a printer) comprising the steps of: receiving an instruction (S 41, fig. 14) for a printing process; judging whether an image corresponding to an image signal developed represents a specified image (S43, S 47, fig. 14) according to the printing process; and outputting a result (the output of steps S 43 or S47, fig., 14, column 14, line 67, column 15, line 1) obtained in said judging step so as to use the result in a process (image formation is suspended or not, column 15, lines 15-25) of the image signal.

Regarding claim 27: Koboki teaches wherein said judging step executes judgement for an image corresponding to the image signal and plural specific images (specific originals, column 14, lines 60-67).

Regarding claim 30: Koboki teaches wherein said judging step terminates (step 43 terminates and branch to step S 47, fig. 14) when there is obtained a high judgment rate indicating that the image corresponding to the obtained image signal is a specific image.

Regarding claim 46: Kuboki teaches printer (printer, column 14, line 23) adapted for printing an image from the printer driver according to claim 21.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

16. Claims 24, 28, 29, 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuboki et al. (US 5,790,165).

Regarding claim 24: Kuboki, in embodiment 2 does not teach wherein said judging step execute judgement using template matching.

Kuboki, in embodiment 3 teaches a judging step execute judgement using template matching of matching the supplied image data (column 19, line24-25) to the specific original documents.

Since using template matching for judging an image represents a specific image is already being used by Kuboki, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Kuboki's second embodiment to include: wherein said judging step execute judgement using template matching.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Kuboki's second embodiment by the teaching of third embodiment because: (a) it would have provided an easy and known method of allowing the image data to be judged; and (b) it would reduced the cost of the system for Kuboki does not need to spend time and money to research by using a method already known to Kuboki.

Regarding claim 28: Koboki, in embodiment 2, does not teach wherein said judging step executes judgement with an image signal obtained by spatial thinning of the image signal.

Kuboki, in embodiment 3 teaches judging step executes judgement with an image signal obtained by spatial thinning of the image signal (column 19, lines 10-13).

Since using spatial thinning of the image signal for judging an image represents a specific image is already being used by Kuboki, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Kuboki's second embodiment to include: judging step executes judgement with an image signal obtained by spatial thinning of the image signal.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Kuboki's second embodiment by the teaching of third embodiment because: (a) it would have provided an easy and known method of allowing the image data to be judged; and (b) it would reduced the cost of the system for Kuboki does not need to spend time and money to research by using a method already known to Kuboki.

Regarding claim 29: Koboki, in embodiment 2, does not teach wherein said judging step executes with an image signal obtained by reducing the number of bits of the image signal.

Kuboki, in embodiment 3 teaches a judging step executes with an image signal obtained by reducing the number of bits of the image signal (column 17, lines 10-15).

Since using reducing the number of bits of the image signal for judging an image represents a specific image is already being used by Kuboki, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to

have modified Kuboki's second embodiment to include: the judging step executes with an image signal obtained by reducing the number of bits of the image signal.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Kuboki's second embodiment by the teaching of third embodiment because: (a) it would have provided an easy and known method of allowing the image data to be judged; and (b) it would reduced the cost of the system for Kuboki does not need to spend time and money to research by using a method already known to Kuboki.

Regarding claim 34: Kuboki does not teach, in embodiment 2, a computer readable memory medium which stored codes for executing the method according to claim 21.

Kuboki, in the first embodiment teaches a computer readable memory medium which stored program codes for controlling execution of program steps (column 11, lines 35-40).

Since Kuboki's printer driver is a control device and a computer readable memory medium which stored codes for controlling is already being used by Kuboki, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Kuboki's second embodiment to include: a computer readable memory medium which stored codes for executing the method according to claim 21.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Kuboki's second embodiment by the teaching

of third embodiment because: (a) it would have provided an easy and known method of implementing a control progrom; and (b) it would have prevented the lost of the created program.

Allowable Subject Matter

17. Claims 22, 23, 25, 26, 31, 33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to King Y. Poon whose telephone number is (703) 305-0892.

3/21/04